

This is in response to Federal Register Volume 77, Number 77 (Friday, April 20, 2012)]
[Notices][Pages 23662-23665] DEPARTMENT OF COMMERCE United States Patent and Trademark Office
[Docket No. PTO-P-2012-0012]

“Notice of Request for Comments on the Feasibility of Placing
Economically Significant Patents Under a Secrecy Order and the Need To
Review Criteria Used in Determining Secrecy Orders Related to National
Security”

“SUMMARY: Pursuant to a request from Congress, the United States Patent
and Trademark Office (USPTO) is seeking comments as to whether the
United States should identify and bar from publication and issuance certain patent applications as
detrimental to the nation's economic security. The USPTO is also seeking comments on the desirability
of changes to the existing procedures for reviewing applications that might be detrimental to national
security.

Those wishing to submit written comments should submit those
comments for consideration by June 19, 2012.”

Comments:

First, the term “detrimental to the nation's economic security” is self-evidently unworkably ambiguous,
and would add burdens and delays to USPTO application processing, and litigation over disputed such
classifications, adversely affecting U.S. companies.

Secondly, any invention of real economic value would normally be important enough to need to file
patent applications for its protection in several foreign countries. Those foreign countries now have
both a much larger total economic market than the U.S. and represent the most likely sources of
competitive manufacturing of the invention absent patent protection in those countries. Yet patent
applications cannot be filed in those countries without their being published in 18 months.

Thirdly, under existing patent law, anyone who does not want their patent application published before
it issues can simply request that, as long as they are not also filing that application in foreign countries
[since those countries will publish it in 18 months]. 35 USC §122(b)(1)(B)

Fourthly, under current patent law the owner of a pending patent application can obtain reasonable
royalties for infringements occurring during its pendency if they have provided timely notice thereof to
infringers and the patent issues with an infringed claim substantially identical to at least one application-
published claim. 35 USC §154(d) “Provisional rights.”

Fifthly, it is respectfully submitted that mixing this “economic security” issue with the existing “secrecy
order” related questions in this PTO request for public comments is further confusing “economic
security” [whatever was meant by that] with military security - more accurately, military technological
superiority or advantage over foreign potential enemies of the U.S. That is a very different issue.
Furthermore, applications placed under secrecy orders may be suppressed from patent protection and
public disclosure for many years, and it can be difficult to obtain their release from that limbo status
even after the technology has become obsolescent and/or has become publicly available from other

sources. Furthermore, what is the appropriate patent term when these long delayed applications are finally allowed to issue?

As to specific PTO question No. "17. Among patent practitioners, is there a common practice of attempting to avoid consideration for a secrecy order by drafting the patent disclosure in such a way as to not raise national security implications of an invention?"

I have no idea if there is or was such a "common practice." However, if, for example, one's client invented a new battery that works well in sea water, it would represent bad and dangerous client counseling to unnecessarily mention in the specification that among the possible applications of this battery that this battery could be used in a torpedo, for example. That would risk having the client's U.S. and foreign patent rights effectively destroyed for all other possible commercial applications, and even allow others to independently obtain later patents on the same invention, if those added words were to possibly cause a secrecy order to be imposed on the patent application.

Respectfully submitted,
Paul F. Morgan
[retired patent attorney]